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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,845	05/31/2001	Henri Waelbroeck	10209-008	9460
20583	7590	05/26/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/870,845	WAELBROECK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH PATEL	3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 are, drawn to a method of managing securities market information, wherein a dissemination list is computed based on order-related or trade related query received from a securities market participant classified in class 705, subclass 37 (securities trading).
  - II. Claims 6-12 are, drawn to a method of managing securities market information, wherein a dissemination list is computed based on securities order parameters received from a market participant and on securities order- or trade-related data regarding a set of securities market participants, computing a dissemination list of securities market participants based on ranking likely contras by probability of execution; classified in class 705, subclass 37 (securities trading).
  - III. Claims 13-17 are drawn to a method of effecting a targeted auction, classified in class 705, subclass 26 wherein the auction is conducted among orders including orders received in response to data transmitted to the market participants on a targeted dissemination list ; wherein in the auction an order is displayed as a passive order and executes immediately against contra orders at that price, but upgrades its price to a more aggressive price for randomly-scheduled match check events where neither party has control of time of execution.

- IV. Claims 18-26 are drawn to a method of effecting a targeted auction, classified in class 705, subclass 37 wherein market participants have the option of placing an order in an order depository without initiating an auction or invoking targeted dissemination of data, said orders being dormant until an auction is initiated in that stock;
- V. Claims 27-41 are directed to a method of managing orders in a securities market classified in class 705, subclass 37 (securities trading) based on searching a database (having stored therein an order and conditions received from a market participant) for contra orders that satisfy the conditions and ranking the contra orders satisfy the conditions criteria comprising said conditions.
- VI. Claims 42-52 are directed to a method of managing orders in a securities market classified in class 705, subclass 37 (securities trading) based upon data received from a market participant wherein the data comprises a first preference order and conditions thereon wherein the first preference order is directed to a preferencing ID and sending a second preference order to a second market participant with an optimum or optimal ranking.
- VII. Claims 53-56 are drawn to a method of effecting a targeted auction, classified in class 705, subclass 26. The auction is conducted among orders including orders received in response to data transmitted to selected market participants and electronic auction an order is displayed as a passive order and executes

immediately against contra orders at that price, but upgrades its price to a more aggressive price for randomly-scheduled match check events where neither party has control of time of execution.

- VIII Claims 57-61 are directed to a method of managing orders in a securities market classified in class 705, subclass 37 comprising matching a second order against a first order if the price and size match and if the first participant information indicates that said first order is exposed to immediate matching against incoming orders; and executing randomly-timed match check events wherein other orders will match against the first order if the price and size match and if said first participant information indicates that said first order is to be exposed to randomly-timed match check events.
- IX. Claims 62 is drawn to a method of effecting a targeted auction, classified in class 705, subclass 26.
- X. Claims 63-67 are, drawn to a method of managing securities market information, wherein a dissemination list is computed based on order-related or trade related query received from a securities market participant classified in class 705, subclass 37 (securities trading).
- XI. Claims 68-71 are, drawn to a method of managing securities market information, wherein classified in class 705, subclass 37 (securities trading).

2. The inventions identifies above recite distinct species identifies in three different genus categories (Refer to categories A-C described under different subject matter). It is asserted that

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inventions in each categories are related as combination and subcombination and are distinct each from the other because of the following reasons:

3. Inventions are identified under subcombinations A (claims 1-12 and 63-71), B (claims 27-52 and 57-61) and C (claims 13-26, 53-56 and 62) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, subcombination B or C do not require the particulars of the subcombination A such as the dissemination list of securities market participants based on order-related or trade related query received form a securities market participant.

Subcombination A or B do not require the particulars of the subcombination C such as effecting a targeted auction. Each of the subcombinations have their respective utilities outlined in the following paragraphs.

4. This application contains claims directed to the following patentably distinct species. The applicant is required to elect any one species from the entire list given below.

A. Species of Managing securities market information.

A-1: computing a dissemination list of securities market participants based on order-related or trade related query received form a securities market participant. (Refers to claims 1-5)

A-2: computing a dissemination list of securities market participants based on ranking likely contras by probability of execution; (Refers to claims 6-12).

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A-3: .. electronically receiving notification from one or more entities who receive information comprising conditions on orders on contra side wherein the notification comprises an indication that a second participant's order matches said conditions (Refers to claims 63-67).

A-4: ..electronically scheduling a match-check event and electronically triggering execution of auctions with orders received at the time of said match-check event (Refers to claims 68-71).

B. Species of Managing orders in a securities Market.

B-1: ..based on searching a database (having stored therein an order and conditions received from a market participant) for contra orders that satisfy the conditions and ranking the contra orders satisfy the conditions criteria comprising said conditions. (Refers to claims 27-41).

B-2: .. based upon data received from a market participant wherein the data comprises a first preference order and conditions thereon wherein the first preference order is directed to a preferencing ID and sending a second preference order to a second market participant with an optimum or optimal ranking. (Refers to claims 42-52).

B-3: .. matching a second order against a first order if the price and size match and if the first participant information indicates that said first order is exposed to immediate matching against incoming orders; and executing randomly-timed match check events wherein other orders will match against the first order if the price and size match and if said first participant information indicates that said

first order is to be exposed to randomly-timed match check events. (claims 57-61).

C. Species of effecting a targeted auction

C-1..wherein the auction is conducted among orders including orders received in response to data transmitted to the market participants on a targeted dissemination list ; wherein in the auction an order is displayed as a passive order and executes immediately against contra orders at that price, but upgrades its price to a more aggressive price for randomly-scheduled match check events where neither party has control of time of execution. (Refers to claims 13-17).

C-2 .. wherein market participants have the option of placing an order in an order depository without initiating an auction or invoking targeted dissemination of data, said orders being dormant until an auction is initiated in that stock. (Refers to claims 18-26).

C-3 .. wherein the auction is conducted among orders including orders received in response to data transmitted to selected market participants and electronic auction an order is displayed as a passive order and executes immediately against contra orders at that price, but upgrades its price to a more aggressive price for randomly-scheduled match check events where neither party has control of time of execution. (Refers to claims 53-56).

C-4 .. producing a targeted dissemination list of market participants based on confidential information regarding market participants and order information



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received from a first market participant and checking order parameters for matching and execution of a second participant's and a third participant's order against the first order. (Refers to claim 62).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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7. A telephone call was made to Steven D. Underwood (Reg. No. 47,205) on 5/24/06 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

### ***Conclusion***

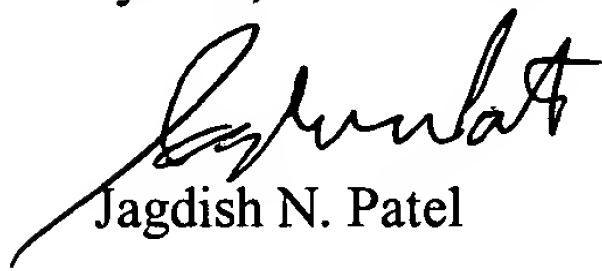
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/24/06